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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/929,184
Filing Date: August 14, 2001
Appellant(s): WILCE ET AL.

Patrick J. Buckley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 18, 2007 appealing from the Office action mailed December 15, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Pub No US 2002/0087534 A1 to Blackman et al.

Pub No US 2002/0188539 A1 to Axelrad et al.

Srinivasan, Sriram. Advanced Perl Programming. 1997 from Google books.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 3-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub. No. US 2002/0087534 A1 to Blackman et al. (further referred to as Blackman), in view of Pub. No. US 2002/0188539 A1 to Axelrad et al. (further referred to as Axelrad), and further in view of Advanced Perl programming by Sriram Srinivasan in 1997 (further referred to as Perl).

Regarding claims 1, 16 and 19, Blackman discloses a method, apparatus and medium storing instructions adapted to be executed by a processor to perform a method for facilitating generation of an agreement document associated with a financial transaction agreement between a party and a counter-party (page 1, paragraphs 1 and 7), comprising:

A processor (page 2, paragraphs 12-13 and 38);

A storage device in communication with said processor and storing instructions adapted to be executed by said processor to (page 3, paragraphs 40-47);

Receiving agreement information from a user associated with the party, the agreement information including (i) a counter-party communication address (page 4, paragraph 62);

Determining an agreement scope, a document scope, and a fact set scope (page 3, paragraph 40; page 11, paragraph 244);

Generating the agreement document in accordance with the information (page 1, paragraph 7; page 3, paragraph 30; page 5, paragraphs 52 and 54);

Automatically transmitting the agreement document to the counter-party via the counter-party communication address (page 3, paragraphs 40 and 47; page 4, paragraph 62; page 10, paragraph 237).

Blackman does not disclose information about a financial product associated with the financial transaction agreement; and generating the agreement document in accordance with information about the financial product and a covered products matrix. However, Axelrad discloses information about a financial product associated with the financial transaction agreement (page 2, paragraph 29; page 3, paragraphs 32 and 38); and generating the agreement document in accordance with information about the financial product and a covered products matrix (page 3, paragraph 30; page 5, paragraphs 52 and 54). It would be obvious to one of ordinary skill in the art to modify the agreement management system for financial transactions as disclosed by Blackman to adapt the use of financial products and covered products matrix as disclosed by Axelrad. The motivation would be that offering a financial product is one type of financial transaction and Blackman contains the mechanisms for offering financial transaction agreements between parties, whereby a financial product would be one of many such possibilities of offerings.

Neither Blackman nor Axelrad disclose placing the determined agreement scope, document scope, and fact scope in a scope stack and evaluating the scope stack via an evaluation engine to produce a result in accordance with a rule. However, Perl discloses placing the determined agreement scope, document scope, and fact scope in a scope stack and evaluating the scope stack via an evaluation engine to produce a result in accordance with a rule (page 3, lines 36-41). It would be obvious to one of ordinary skill in the art to combine the use of scope stacks as disclosed by Perl with the transaction agreement system as disclosed by Blackman and Axelrad. The motivation would be that the use of scope stacks are used to organize data related to scopes of defined fields and to use them in relation to evaluating data which has been collected and stored.

Regarding claim 3, Blackman discloses the method wherein the counter-party communication address comprises at least one of: (i) an electronic mail address, (ii) an Internet address, (iii) a uniform resource locator, and (v) a telephone number (page 4, paragraph 62).

Regarding claim 4, Blackman discloses the method further comprising automatically transmitting the agreement document via a communication address associated with the party (page 3, paragraph 47; page 4, paragraph 62; page 10, paragraph 237).

Regarding claim 5, Blackman discloses the method wherein the party is associated with a first party entity and a second party entity (page 1, paragraph 7), and further comprising:

Transmitting the agreement document via a first communication address associated with the first party entity (page 2, paragraph 38; page 3, paragraph 47; page 4, paragraph 62);

Receiving information from the first party entity (page 1, paragraph 7; page 3, paragraph 47); and

Transmitting the agreement document via a second communication address associated with the second party entity (page 2, paragraph 38; page 3, paragraph 47; page 4, paragraph 62; page 10, paragraph 237).

Regarding claim 6, Blackman discloses the method wherein the agreement document comprises at least one of: (i) a final agreement document, and (ii) an amendment to an existing agreement document (page 4, paragraphs 74-78; page 9, paragraph 220; page 10, paragraphs 231 and 236-237).

Regarding claim 7, Blackman disclose the method wherein the agreement document comprises a preliminary agreement document (page 1, paragraph 7; page 3, paragraph 47; page 11, paragraph 244).

Regarding claim 8, Blackman discloses the method wherein said transmitting comprises automatically transmitting the preliminary agreement document via the counter-party communication address associated with the counter-party (page 2, paragraph 38; page 3, paragraph 47; page 4, paragraph 62), and further comprising receiving a revised preliminary agreement from the counter-party (page 4, paragraph 70-71 and 72-78; page 14, paragraph 287; page 15, paragraph 305).

Regarding claim 9, Blacker discloses the method further comprising reconciling the revised preliminary agreement document and the preliminary agreement document; and generating a final agreement document in accordance with said reconciliation (page 16, paragraph 331).

Regarding claim 10, Blackman discloses the method where said generating comprises automatically generating a plurality of agreement documents in accordance with the information (page 9, paragraph 220; page 10, paragraph 236).

Blackman does not disclose generating the agreement document in accordance with information about the financial product and a covered products matrix. However, Axelrad discloses generating the agreement document in accordance with information about the financial product and a covered products matrix (page 3, paragraph 30; page 5, paragraphs 52 and 54). It would be obvious to one of ordinary skill in the art to modify the agreement management system for financial transactions as disclosed by Blackman to adapt the use of information regarding financial products and covered

products matrix as disclosed by Axelrad. The motivation would be that offering a financial product is one type of financial transaction and Blackman contains the mechanisms for offering financial transaction agreements between parties, whereby a financial product would be one of many such possibilities of offerings.

Regarding claim 11, Blackman discloses the method wherein the agreement information comprises at least one of: (i) an agreement type, (ii) an agreement term, and (iii) an agreement fact (page 3, paragraph 40; page 4, paragraph 53; page 9, paragraph 222).

Regarding claim 12, Blackman discloses the method wherein the agreement comprises a transaction agreement associated with at least one of: (i) a set of rights between the party and the counter-party, (ii) a legal contract, (iii) a financial instrument, and (iv) a monetary amount (abstract; page 1, paragraph 9).

Regarding claims 13 and 14, Blackman does not disclose the method wherein the financial product comprises at least one of: (i) an equity product, (ii) a stock product, (iii) an index product, (iv) a fixed income product, (v) a bond product, (vi) a bank loan product, (vii) a whole loan product, (viii) an interest rate product, (ix) a credit derivative product, (x) a commodity product, (xi) a metal product, (xii) an energy product, and (xiii) an agricultural product, and where at least one transaction instrument comprises: (i) a swap instrument, (ii) an option instrument, (iii) a buy instrument, (iv) a sell instrument,

(v) a call instrument, (vi) a put instrument, (vii) a forward instrument, (viii) a pre-paid forward instrument, (ix) a spot instrument, (x) a repurchase agreement instrument, (xi) a loan instrument, (xii) a warrant instrument, and (xiii) a contract for differences instrument.

However, Axelrad discloses the method wherein the financial product comprises at least one of: (i) an equity product, (ii) a stock product, (iii) an index product, (iv) a fixed income product, (v) a bond product, (vi) a bank loan product, (vii) a whole loan product, (viii) an interest rate product, (ix) a credit derivative product, (x) a commodity product, (xi) a metal product, (xii) an energy product, and (xiii) an agricultural product, and where at least one transaction instrument comprises: (i) a swap instrument, (ii) an option instrument, (iii) a buy instrument, (iv) a sell instrument, (v) a call instrument, (vi) a put instrument, (vii) a forward instrument, (viii) a pre-paid forward instrument, (ix) a spot instrument, (x) a repurchase agreement instrument, (xi) a loan instrument, (xii) a warrant instrument, and (xiii) a contract for differences instrument (pages 1-6).

It would be obvious to one of ordinary skill in the art to combine the financial products and instruments as disclosed by Axelrad with the agreement system as disclosed by Blackman. The motivation would be that transaction agreements would include the trading of financial products and where financial instruments are to be bought, sold, traded, etc. such that the impetus for developing an agreement would be to facilitate such a transaction.

Regarding claim 15, Blackman discloses the method wherein said generating is performed via at least one of: (i) a covered product matrix information retrieved from a database, (ii) a pre-stored default transaction term, (iii) information received from a user of an agreement modeling system, (iv) information received from a satellite system, and (v) information received from a legacy agreement system (page 1, paragraph 7; page 2, paragraph 38; page 3, paragraphs 40 and 47).

Regarding claim 17, Blackman discloses the apparatus wherein said storage device further stores an agreement information database (page 3, paragraph 40).

Regarding claim 18, Blackman discloses the apparatus further comprising a communication device coupled to said processor and adapted to communicate with at least one of: (i) a client device, (ii) an agreement modeling system controller, (iii) a satellite system, and (iv) a counter-party device (page 2, paragraph 38).

(10) Response to Argument

The Appellant's arguments have been considered but are not persuasive.

Appellants submit that "the Perl reference does not disclose or suggest 'determining an agreement scope, a document scope, and a fact set scope' nor 'placing the determined agreement scope, document scope, and fact set scope in a scope stack' nor does the Perl reference disclose or suggest that such a scope stack is evaluated

'via an evaluation engine to produce a result in accordance with a rule'". Appellants further argue the establishment of a prima facie case of obviousness in combining the Perl reference with the combination of Blackman and Axelrad.

First, regarding appellants' arguments regarding the Perl reference and its lack of disclosure of 'determining an agreement scope, a document scope, and a fact set scope'. Examiner points to the Final Office Action where it is cited that the primary reference, Blackman, discloses the limitation of 'determining an agreement scope, a document scope, and a fact set scope' at page 3, paragraph 40 and page 11, paragraph 244. Perl is not intended to address this limitation as it is found within the disclosure of the primary reference.

Appellants argue that Perl does not disclose 'placing the determined agreement scope, document scope, and fact set scope in a scope stack' nor where a scope stack is evaluated 'via an evaluation engine to produce a result in accordance with a rule'. Perl discloses the use of scope stacks. Scope stacks are known in the industry and field of computer technology as an evaluation method by which data elements are entered into the scope stack in order to be evaluated with a result. As quoted in the Appeal Brief from the Perl reference...

"The scope stack is used to remember positions along the save stack that correspond to different scopes..."

The preceding paragraph in the Perl reference discusses the save stack in which it is stated...

"This stack is used as a repository for storing all pieces of global information that are liable to change within a nested scope..."

Further, as additional and supplemental information, Examiner offers a quote from *Computer Dictionary, 2nd edition*, where a stack is defined as...

"a region of reserved memory in which programs store status data such as procedure and function call return address, passes parameters, and (sometimes) local variables. The microprocessor, the program, and the operating system can all maintain one or more separate stacks. A stack is usually a data structure organized as a LIFO (last in, first out) list so that the last data item added to the structure is the first item used."

The use of scope stacks for storing information for evaluation and processing is known in the field of computer technology, and is a mechanism used in memory management. Using a scope stack to store any data or information is within the applicability of a scope stack. And as is clear from the dictionary reference above, a microprocessor, program and operating system (evaluation engine) are used for producing a result according to rules. Placing the determined agreement scope; document scope, and fact set scope in a scope stack would be obvious to one of ordinary skill in the art as scope stacks are used "behind the scenes" in computer functioning to evaluate variables and produce a result in accordance with programming and processing rules.

In response to Applicant's argument that it would not have been obvious to modify the cited prior art reference(s) to create the claimed invention, the Courts have

stated that "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." KSR Int'l Co. v. Teleflex, Inc. 127 S. Ct. 1727, 1740, 92 USPQ2d 1385, 1396 (2007).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interference section of this Examiner's Answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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